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EXAMINER

FLEURANTIN, JEAN B

ART UNIT

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* FUJIO MORITA

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Appeal 2008-1688  
Application 09/841,038  
Technology Center 2100

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Decided:<sup>1</sup> March 25, 2009

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Before LANCE LEONARD BARRY, ST. JOHN COURTENAY III, and  
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-12. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

### *The Invention*

The disclosed invention relates to searching and classifying web site addresses (Spec. 1).

Independent claim 1 is illustrative:

1. A search support device, implemented on a client computer, in which an address indicating a location of information accessible on a network is registered, the device comprising:

a search unit that determines a hierarchical category of an address designated for registration based on a definition entry and a selection record of a menu; and

a registration unit that registers an address in the hierarchal category,

wherein predetermined search information is registered for each category, which predetermined search information is used as a keyword for searching for the address indicating a location of desired information accessible on the network, and

wherein, when a new keyword is searched for by using a combination of a plurality of upper level keywords, the registration unit generates a lower level category corresponding to the new keyword, and registers the lower level category in a manner to be linked to an upper level category.

### The Reference

The Examiner relies upon the following reference as evidence in support of the rejection:

Haruhiro

JP 10031683 A

Feb. 03, 1998

### *The Rejection*

The Examiner rejects claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over the instant Specification (“Related Art”) and Haruhiro.

### ISSUE

Appellant asserts that Related Art fails to disclose or suggest “a hierarchical category of an address [...] based on a definition entry and a selection record of a menu” (App. Br. 7) or that ““when a new keyword is searched for by using a combination of a plurality of upper level keywords, the registration unit generates a lower level category corresponding to the new keyword, and registers the lower level category in a manner to be linked to an upper level category”” (*id.*). Appellants further argue that “Haruhiro fails to correct or compensate for the . . . failure of the ‘Background Art’ section” of Related Art (*id.*).

Did Appellants demonstrate that the Examiner erred in finding that the instant Specification and Haruhiro discloses or suggests determining a hierarchical category of an address designated for registration and using a combination of a plurality of upper level keywords when a new keyword is

searched for to generate a lower level category corresponding to the new keyword and registering the lower level category in a manner to be linked to an upper level category?

### FINDINGS OF FACT

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

1. Related Art discloses a user inputting search terms to search for a “homepage supposedly containing desired information” (Spec 2, ll. 27-28) and registering a corresponding bookmark “so that the homepage can be promptly accessed . . . next time the user makes an access to the homepage” (Spec. 2, ll. 22-25).
2. Haruhiro discloses servers storing and collecting “URL information” (¶[0034]) in a network in which one “server . . . belongs to a hierarchy layer upper than the [other] servers” (*id.*) and that a “retrieval server . . . collects URL information of all the WWW server which belong to lower hierarchies” (*id.* 17).

### PRINCIPLES OF LAW

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and

(3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

### ANALYSIS

While the Examiner demonstrates that Related Art discloses creating bookmarks for accessing websites (FF 1) and Haruhiro discloses a server in a network obtaining URL information from other servers arranged in a hierarchical pattern with other servers in the network (FF 2), we do not find, and the Examiner has not demonstrated, that Related Art and/or Haruhiro teaches or fairly suggests determining a hierarchical category of an address and using a combination of upper level keywords to generate a lower level category and registering the lower level category linked to the upper level category.

The Examiner finds that Related Art discloses that a “bookmark is registered, so that the homepage can be promptly accessed by simply selecting the URL address from a list of registered bookmark; see page 2, lines 18-25” (Ans. 10) and equates this disclosure in Related Art with using a combination of a plurality of upper level keywords when a new keyword is searched to generate a lower level category corresponding to the new keyword and registering the lower level category in a manner to be linked to an upper level category, as recited in independent claim 1. However, the Examiner does not demonstrate how merely registering a bookmark for a homepage (Related Art) and/or arranging servers in a network in a

hierarchical pattern and obtaining URL data from such servers (Haruhiro) is equivalent or suggestive of the disputed claimed features. In the absence of a specific showing by the Examiner, we do not find that registering a bookmark and/or obtaining URL data from a group of servers is fairly suggestive of determining a hierarchical category of an address and using a combination of upper level keywords when a new keyword is searched to generate a lower level category corresponding to the new keyword and registering the lower level category in a manner to be linked to an upper level category. Indeed, the concepts appear not to be substantially related.

Accordingly, we conclude that Appellants have met their burden of showing that the Examiner erred in rejecting independent claim 1, independent claims 3, 4, 8-10, and 12, which recite equivalent limitations to those discussed above regarding independent claim 1, and dependent claims 2, 5-7, and 11, which depend from independent claim 1, 4, or 10.

#### CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have demonstrated that the Examiner erred in finding that the instant Specification and/or Haruhiro discloses or suggests determining a hierarchical category of an address designated for registration and using a combination of a plurality of upper level keywords when a new keyword is searched for to generate a lower level category corresponding to the new

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keyword and registering the lower level category in a manner to be linked to an upper level category.

DECISION

We reverse the Examiner's decision rejecting claims 1-12 under 35 U.S.C. § 103.

REVERSED

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